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APPLICATION NO.	FILING DATE	/	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,081	03/06/2002		Richard P. Szajewski	81246ACPK	1514

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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 12/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant N .

10/092,081

Applicant(s)

SZAJEWSKI, RICHARD P.

Examiner

Thorl Chea

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This application is a CIP of the Application serial No. 09/855,046 wherein claims 1-15 were directed to the elected invention without traverse and claims 16-26 were directed to non-elected invention. The inventions of claims 1-15 are withdrawn from consideration since the claims were considered in the parent application. In any event wherein the applicants request to reconsider claims 1-15, the rejections issued in the parent application are reissued in this office action and provided below since the claims of both application are identical. The translation of JP4-86658 is also provided.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 6, 8, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 6 are indefinite with respect to the term "conventional" since there is no specific standard to differentiate between what is conventional and what is unconventional. The scope of protection sought for the "hue-shifting developing agent or precursor thereof" is indefinite since the specification fails to clearly define the scope thereof. A few specific examples such as paraphenyl dimamine developer fails to represent the entire scope of hue-shifting agent presented in claim 8. The term "type" render claim 9 indefinite. "type", *Ex parte Copenhaver*, 108 USPQ 118.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 11-14 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP4-86658 (JP'658).

JP'658 discloses a heat developable color photosensitive material containing a dye providing substance and an infrared dye forming coupler. On page 556, first column line 19, it discloses the use of the infrared dye forming coupler in a photosensitive silver halide layer containing a cyan dye; the use of a color developing agent such as paraphenylene compound is shown on page 565, second column; the heat developable color photosensitive material containing yellow, magenta and cyan coupler is shown in Table 2 on page 567. The JP'568 discloses therefore the use of an infrared dye forming coupler and a paraphenylene diamine type in a cyan coloring layer of a heat

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developable within the meaning at least one image recording layer in the recording layer units within the scope of claim 1 of the present claimed invention. Therefore, JP'658 anticipates the claimed invention. Alternatively, it would have been prima facie obvious to the skill of ordinary skill in the art to use the infrared dye-forming layer taught in JP'658 such as suggested therein to provide a material as claimed. The invention in claim 8 is related to the use of hue-shifting developing agent thereof. This developing agent is similar type of that taught in the JP'658 discussed above. The property such as hue-shifthing due to the developing agent or precursor thereof is inherent to the of infrared dye and the paraphenylene diamine type developing agent taught in the JP'658. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious over JP'658.

7. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato as applied to claims 1-7, 11-14 above, and further in view of Bohan et al ('470) Bohan in column 11 discloses that overall, the limited Dmin and tone scale density enabled by controlling the quantity of incorporated masking coupler, incorporated permanent Dmin adjusting dyes and support optical density can both limit scanning noise and to improve the overall signal-to-noise characteristic of the film to be scanned. It would have been obvious to include the color masking coupler, permanent Dmin adjusting dyes and the optical density in the materil of Kato to limit scanning noise and improve the overall signal-to-noise characteristic of the film to be scanned.

8. Claims 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishikawa et al (Ishikawa).

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Ishikawa discloses a color photographic material containing a paraphenylene diamine compound similar to that of the present claimed invention. See especially samples 2-3 in column 16, developer compound A, and column 19, claim 1, formula (I). Ishikawa may not disclose the term "hue-shifting" such as presented in the present claimed invention; but the developer use therein has similar functional group. Accordingly, the property such as "hue-shifting" is inherent to the dye of Ishikawa. The absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found obvious over Ishikawa.

9. Claims 16-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Kokai Patent Publication No. 4-86658 (Kato) in view Bohan et al ('470).

The process of the claimed invention is directed to the use of a photothermographic element wherein at least one image record employs an infrared dye for image formation. The invention in claim 16 is related to the scanning of the material wherein the substantially all the silver halide has not been removed; claim 17 is related to the scanning before removing silver halide from the film; and claim 18 is related to the scanning after partial desilvering.

Kato discloses a heat developable color sensitive material containing discloses a heat developable color photosensitive material containing a dye providing substance and an infrared dye forming coupler. Page 9 of the translation discloses that the IR coupler and the dye supplying substances contains in the same layer or in different layers; it is preferred the use of the IR coupler in the cyan-dye supplying substance. The "IR image" is disclosed on page 28, lines 12-15. Thus, IR dye taught in Kato and IR dye

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present in the claimed invention has similar function, i.e., recording an image. Boha in the abstract discloses the process of scanning to form density representative digital signals for color record after development, and optionally desilvering and fixing. Kato does not disclose the scanning process claimed in the present invention, which is scanning before removal of silver halide from the film, but it has been known in Bohan that scanning process can be performed before desilvering. Thus, it would have been obvious to the worker of ordinary skill in the art to scan the developed photothermographic material taught in Kato to form density representative digital signals for color record.

### ***Double Patenting***

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 1-15 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15, 27-28 of copending Application No. 09/855,046. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

**Conclusion**


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The foreign patent documents cited in the PTO-1449 have not been considered since there were no copies of the document were provided.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea   
December 26, 2002

  
Thorl Chea  
Primary Examiner  
Art Unit 1752